REMARKS

The above Amendments and these Remarks are in reply to the Office Action mailed July 12, 2007.

Currently, claims 1-3, 5-15, 17-24, 26-35, 37-42, and 44-52 are pending. Applicants have amended claims 49 and 50 and added new claims 51 and 52. Applicants respectfully request reconsideration of claims 1-3, 5-15, 17-24, 26-35, 37-42, and 44-52.

I.   Amendments to the Claims

Applicants have amended dependent claims 49 and 50 and have added new dependent claims 51 and 52. Applicants respectfully assert that these amendments comply with 37 C.F.R. §1.116.

Furthermore, Applicants assert that the amendments to the claims do not require any additional search because all of the limitations in the amended and new claims are limitations from previously submitted claims.

Lastly, Applicants assert that the amendments place the application in better form for appeal. Therefore, applicants respectfully request that these amendments be entered.

II.   Rejection of Claims 1, 7, 8, 10, 12, 13, 20, and 39 Under 35 U.S.C. §102(e)

Claims 1, 7, 8, 10, 12, 13, 20, and 39 have been rejected under 35 U.S.C. §102(e) as being anticipated by Berkley (US 6,351,843). Because Berkley does not disclose all of the limitations of claims 1, 7, 8, 10, 12, 13, 20, and 39, Applicants assert that the claims are patentable over the cited prior art.

Claim 1 is not anticipated by Berkley because Berkley does not disclose "determining whether to modify said method, said step of determining whether to modify said method includes determining whether said method calls another method." As discussed in the previous response to the office action dated January 3, 2007, Berkley discloses a technique for activating a function, such as a tracing function, in an application executable through the modification of configuration settings for the executable. For example, a user can modify the configuration

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settings "at runtime to add a setting to specify… tracing for a desired class of the executable 310, thereby producing new configuration settings" (see Fig. 5 and col. 6, lines 53-56). When the application executable is executed, the system determines "whether the functions are active for a class of the executable using the modified configuration settings" (col. 2, lines 39-40). If the user modifies the configuration settings to set the functions active for a class, the application executable will perform the active functions during execution.

The Examiner argues that Berkley's step of "determining whether the function is active" (col. 2, lines 39-40) can be equated to the step of "determining whether said method calls another method," as recited in claim 1. However, these features are not equivalent. According to Berkley, determining whether a "method" is active simply determines whether a user has specified the class for that "method" through the modification of the configuration settings. Nowhere in Berkley does it disclose "determining whether said method calls another method." Berkley only discloses determining whether the "method" is active (i.e. has been specified by the user through configuration settings), which is not related to whether the "method calls another method."

Additionally, the Examiner points out that Berkley's Figure 1 and col. 1, line 48 – col. 2, line 6 describe a "method [that] calls another method." Although Berkley does describe one method calling another method, the decision to "modify said method" is not based on this. Instead, Berkley will only "modify said method" if the user sets the configuration settings to do so. Thus, in Berkley, the step of "determining whether to modify" is carried out by checking the configuration settings, not by "determining whether said method calls another method."

Because Berkley does not disclose the "determining" step of claim 1, the reference does not anticipate the claim. Therefore, claim 1 is patentable over the cited prior art. Claims 7, 8, 10, 12, 13, 20, and 39 each contain a similar feature and are therefore patentable over the cited prior art for at least the same reasons as claim 1. Applicants respectfully request reconsideration of these claims.

New claims 51 and 52 are patentable over the cited prior art for at least the same reasons as claim 1. Applicants respectfully request consideration of claims 51 and 52.

III.   Rejection of Claims 2, 3, 5, 6, 14, 15, 17, 18, 40-42, 44, and 47-50 Under 35 U.S.C. §103(a)

Claims 2, 3, 5, 6, 14, 15, 17, 18, 40-42, 44, and 47-50 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Berkley. Because the cited prior art, together with the knowledge of one having ordinary skill in the art, does not teach or suggest all of the limitations of the rejected claims, Applicants assert that the claims are in condition for allowance.

Berkley does not teach or suggest "determining whether to modify said method, said step of determining whether to modify said method includes determining whether said method calls another method." Furthermore, it would not be obvious to one of ordinary skill in the art to develop the claimed features. The knowledge of one having ordinary skill in the art adds nothing regarding "determining whether to modify said method... [including] determining whether said method calls another method" since it would not be obvious to "modify said method" based on these limitations. Therefore, Berkley would not lead one of ordinary skill in the art to develop the claimed invention as described in claims 2, 3, 5, 6, 14, 15, 17, 18, 40-42, 44, and 47-50. Applicants respectfully request reconsideration of these claims.

IV.   Rejection of Claims 9, 11, 19, 21-24, 26-35, 37, 38, 45, and 46 Under 35 U.S.C. §103(a)

Claims 9, 11, 19, 21-24, 26-35, 37, 38, 45, and 46 have been rejected under 35 U.S.C. §103(a) as being obvious over Berkley in view of Berry (US 6,662,359). Because the cited prior art, alone or in combination, does not teach or suggest all of the limitations of the rejected claims, Applicants assert that the claims are in condition for allowance.

Berkley, as discussed above, does not disclose "determining whether to modify said method, said step of determining whether to modify said method includes determining whether said method calls another method," as recited in claim 1. Claims 9, 11, 19, 21-24, 26-35, 37, 38, 45, and 46 all contain a similar feature. Additionally, Berry does not teach or suggest this feature. Instead, Berry discloses inserting a hook into a class when an exception is called so that the method throwing the exception can be identified, yet no determination based on "whether [a]

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method calls another method" is disclosed. Therefore, the combination of Berkley and Berry does not disclose, teach, or suggest all of the limitations of claims 9, 11, 19, 21-24, 26-35, 37, 38, 45, and 46. Applicants respectfully request reconsideration of these claims.

Based on the above amendments and these remarks, reconsideration of claims 1-3, 5-15, 17-24, 26-35, 37-42, and 44-52 is respectfully requested.

The Examiner's prompt attention to this matter is greatly appreciated. Should further questions remain, the Examiner is invited to contact the undersigned agent by telephone.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: _____September 5, 2007_____   By:_____/Michelle Esteban/_____
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